

REMARKS

By this response, Applicants have not amended the claims. As a result, claims 12-33 remain pending in this application. Reconsideration in view of the following remarks is respectfully requested.

In the Final Office Action, the Office rejects claims 12-27 and 29-33 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Adamske. In order to establish a *prima facie* case of obviousness, the Office must show that (1) every feature is taught or suggested by Adamske; (2) Adamske or generally available knowledge suggests or motivates the modification(s); and (3) one would have a reasonable expectation of success. MPEP 2143. Because the Office fails to establish a *prima facie* case of obviousness, Applicants respectfully request withdrawal of the rejections of claims 12-27 and 29-33 for the following reasons.

CLAIM 12

With respect to claim 12, the Office fails to show, *inter alia*, that every feature of the claimed invention is taught or suggested by Adamske. For example, the Office fails to show that Adamske teaches, *inter alia*, the claimed generating a preview of a configured copy of the document on the server based on a print file and configuration information. In support of its rejection, the Office again cites column 5, line 64 through column 7, line 15 of Adamske as allegedly teaching this feature. Applicants again respectfully traverse this holding.

Interpreting Adamske only for the purposes of this response, the cited portion of Adamske teaches creating web-viewable print preview files by converting a converted printable electronic document into a series of graphical preview images (col. 6, lines 1-7). “At the print

preview stage, user 10 can see the document as it will print... Based on this preview..., user 10 can make changes to the electronic document, re-upload the electronic document for conversion, and preview the document once again...” (col. 3, line 64-col. 4, line 2). Subsequently, “[a]fter user 10 verifies the print preview, at operational screen 70 user 10 can select media options..., output handling options..., and destination(s)/recipient(s).” (col. 6, lines 58-62). Consequently, contrary to the Office’s assertion, Adamske fails to teach, *inter alia*, the claimed generation of a preview based on anything other than a converted printable electronic document, which may be generated from a modified and re-uploaded electronic document.

In response to similar arguments previously presented by Applicants, the Office states that “[w]hen the preview is view[ed] at any point the user may make changes to the document and generate a new preview” (page 12 of Final Office Action). Applicants acknowledge that this portion of the Office’s statement is accurate as indicated in the discussion at col. 3, line 64-col. 4, line 2 of Adamske. However, the Office then alleges that the changes “would include changing configuration options such as black and white or color printing which could then be incorporated into the new preview” (page 12 of Final Office Action). In support of this conclusion, the Office cites col. 6, line 58-col. 7, line 15 and col. 3, line 64-col. 4, line 8 of Adamske.

Applicants note that col. 6, line 58-col. 7, line 15, the only portion of Adamske that discusses the selection of color or black and white printing (col. 6, line 60) expressly discusses options selected “[a]fter user 10 verifies the print preview” (col. 6, line 58). To this extent, the color or black and white selection is performed using operational screen 70 (col. 6, lines 58-59), which does not enable the user to modify the electronic document (FIG. 3). Clearly, contrary to

the Office's assertion, the selection of color or black and white printing discussed in col. 6, line 60 is unrelated to modifying an electronic document that then must be re-uploaded and converted to generate a print preview as discussed at col. 3, line 64-col. 4, line 2 of Adamske.

In light of the above, Applicants respectfully submit that the Office has failed to show that Adamske teaches or suggests each and every feature of the claimed invention. As a result, Applicants respectfully request withdrawal of the rejection of claim 12 and claims 13-16, which depend therefrom, as allegedly being obvious in view of Adamske. Alternatively, should the Office maintain this rejection, Applicants respectfully request that the Office cite that portion of Adamske that allegedly teaches or suggests that the media options discussed beginning in col. 6, line 58 are modified when the user modifies the electronic document and subsequently used to generate a print preview as alleged by the Office.

CLAIM 17

With respect to claim 17, the Office fails to show, *inter alia*, that every feature of the claimed invention is taught or suggested by Adamske. For example, the Office fails to show that Adamske teaches, *inter alia*, the claimed obtaining memo information, printing a customized memo, and delivering steps. In support of its rejection, the Office cites col. 7, lines 16-56 as allegedly teaching these features. Applicants note that Adamske fails to include any discussion of a memo let alone the claimed customized memo. Rather, Adamske only discusses that "the print job that produces the hard copy document can also include a print out of the packaging instructions selected by the user, a cover sheet, and a shipping label (if applicable)." (col. 7, lines 40-43). To this extent, Adamske lacks any mention of obtaining memo information that is

customized for a recipient at each of a plurality of delivery addresses, let alone printing and delivering the customized memo along with the one or more copies of the document to each of the delivery addresses.

In response to similar arguments previously presented by Applicants, the Office states that “Adamske discloses that a cover sheet and shipping label are received from the client..., and in order for the system to work, at least the shipping label would have to be tailored to each specific recipient, otherwise the document would be improperly shipped.” (page 12 of Final Office Action). To this extent, the Office apparently alleges that a “shipping label” teaches Applicants’ claimed “customized memo”. Applicants strenuously traverse this interpretation of Adamske.

The term “memo” is a commonly used short form of memorandum, which is most commonly defined as “a short note written as a reminder” or “a written record or communication, as in a business office”. *The American Heritage® Dictionary of the English Language, Fourth Edition*, Houghton Mifflin Company, 2000 (available at dictionary.reference.com). In business, memo can also mean “a business statement made by a consignor about a shipment of goods that may be returned”. *Id.* In sharp contrast, a shipping label comprises a label that is attached to a shipping unit and includes data. Definition of “shipping label” available at www.eyefortransport.com/glossary/st.shtml. For example, under the Office’s interpretation, the shipping label apparently includes a delivery address (“otherwise the document would be improperly shipped”).

Even if, *arguendo*, the Office’s interpretation of Adamske’s shipping label is accurate, the shipping label does not reasonably teach or suggest Applicants’ claimed customized memo.

For example, a memo would not be attached to a shipping unit, but would rather inherently be included as part of the shipment enclosed within the shipping unit. Further, Applicants' claimed customized memo is printed based on customized memo information. The claimed customized memo information is necessarily distinct from the claimed plurality of delivery addresses, which are separately obtained in the claimed invention. However, under the Office's interpretation of the claimed customized memo, the only information that is different for each "memo" is the delivery address.

In light of the above, Applicants respectfully submit that the Office has failed to show that Adamske teaches or suggests each and every feature of the claimed invention. As a result, Applicants respectfully request withdrawal of the rejection of claim 17 and claims 18-19, which depend therefrom, as allegedly being obvious in view of Adamske.

CLAIM 20

A. Previously argued features

With respect to claim 20, the Office fails to show, *inter alia*, that every feature of the claimed invention is taught or suggested by Adamske. For example, Applicants note that the Office relies on its interpretation of Adamske with respect to claim 12 in holding that several features of claim 20 are allegedly taught or suggested by Adamske. To this extent, Applicants herein incorporate the arguments presented above with respect to claim 12.

B. System Software

Further, the Office fails to show that Adamske teaches, *inter alia*, the claimed system software that generates a print file on a client based on the document and communicates the print

file to a server, wherein the print file can be directly printed by a printer. In support of its rejection, the Office again cites column 5, line 64 through column 7, line 15 of Adamske as allegedly teaching this feature. Applicants again respectfully traverse this holding.

1. Teachings of Adamske

Interpreting Adamske only for the purposes of this response, Adamske generally discusses two embodiments for a system and method for delivering an electronic document over a network. Under both embodiments, “the electronic document is converted to a user-viewable print preview format that is displayed to user 10 at the user’s computer.” (col. 3, lines 57-59). In the first embodiment, discussed from column 4, line 61 through column 6, line 23, a user uploads an electronic document from a client computer to a web server (see, e.g., col. 5, lines 15-16). The electronic document is then converted to a portable printable format on an application translation server (col. 5, lines 18-66). In order to perform the conversion, “the application translation program [on the application translation server] houses the variety of client applications that users use to create electronic documents.” (col. 5, lines 19-21). In this embodiment, the conversion results in a “converted printable electronic document (e.g., in a PostScript format).” (col. 5, lines 64-66). “The converted printable electronic document is then processed at web server 22 to create web-viewable print preview files for user 10 to view.” (col. 6, lines 1-3).

In the second embodiment, discussed from column 6, lines 24-57, “the client computer includes a print driver program... that is executable to convert the electronic document and provide the print preview capability prior to uploading to the web server.” (col. 6, lines 34-38). In particular, the print driver program “creates a metafile from the electronic document. This

metafile provides user 10 a viewable representation of how the hard copy will look upon printing at printer 40.” (col. 6, lines 46-49). Subsequently, the user “sends this metafile to [the application] translation server through web server and the conversion into a printable (e.g., PostScript) version is performed as previously described.” (col. 6, lines 49-52).

In both embodiments discussed in Adamske, a printable version of the electronic document is expressly generated on an application translation server (e.g., col. 5, lines 18-19, 64-66 and col. 6, lines 49-52) rather than by system software on a client as in the claimed invention.

2. Interpretations by Office

a. In response to similar arguments previously presented by Applicants, the Office alleges that “Adamske teaches that software used on the client can be used to generate a print file and a print preview file” (page 11 of Final Office Action). Applicants strenuously traverse this conclusion. The Office cites col. 6, lines 24-42 of Adamske in support of this statement. However, this portion is devoid of any mention of creating a print file. In fact, in the following paragraph of Adamske (col. 6, lines 43-57), which discusses the functionality of print driver program 14 in greater detail, it is expressly stated that the print file is generated on the application translation server (col. 6, lines 49-52).

b. The Office also states that “[t]he conversion performed by a print driver program performs is equal to the conversion performed on the server in the alternate embodiment, which is converting the document into a printable electronic document (e.g. PostScript)” (page 11 of Final Office Action). Applicants strenuously traverse this conclusion. In particular, contrary to the Office’s assertion, the equivalent conversions taught by Adamske are from an electronic document “to a user-viewable print preview format.” (col. 3, lines 57-58). In one embodiment,

discussed from column 4, line 61 through column 6, line 23, the electronic document is converted to a printable electronic document, which is used to create web-viewable print preview files. In the second embodiment, discussed from column 6, lines 24-57, the electronic document is used to create a metafile that provides a viewable representation of how the hard copy document will look. Adamske expressly states that the metafile is not a printable version of the electronic document since it is provided to the application translation server for “conversion into a printable (e.g., PostScript) version” (col. 6, lines 49-52).

c. The Office also states that “[b]y definition a print driver acts as an interpreter between the operating system or application software and the particular make and model of printer you’re trying to talk to, or in other words a print driver is used to place the data you are working with in condition to be understood by the printing device you are using, or in other words interpreting the file into a file that can be directly printed by the printer.” (pages 11-12 of Final Office Action). Applicants strenuously traverse this conclusion.

While print drivers frequently perform the functions described by the Office, such functions are not necessarily performed by a print driver. For example, Adamske apparently uses the phrase “print driver program” to describe a program that is accessed/executed using the printer interface. However, Adamske’s description of the functions performed by the print driver program expressly contradict the definition proposed by the Office. In particular, Adamske expressly states that its print driver program does not “act[] as an interpreter between the... application software and the... printer...”, “place the data... in condition to be understood by the printing device...”, or “interpret[] the file into a file that can be directly printed by the printer” as alleged by the Office. To the contrary, Adamske expressly states that the print driver program

“creates a metafile from the electronic document. This metafile provides user 10 a viewable representation of how the hard copy document will look upon printing at printer 40.” (col. 6, lines 46-49). However, the metafile cannot be directly printed by the printer. In sharp contrast, Adamske expressly states that the metafile can be sent to translation server 24 where “the conversion into a printable (e.g., PostScript) version is performed as previously described.” (col. 6, lines 50-52).

In light of the above, Adamske clearly does not teach, under either embodiment or the combination thereof, generating a print file on a client and communicating the print file to a server. In sharp contrast, the claimed invention includes system software that generates a print file that can be directly printed by a printer on a client based on the document and communicates the print file to a server. As a result, Adamske fails to teach or suggest the claimed system software.

C. Motivation

With further respect to claim 20, the Office fails to show, *inter alia*, that Adamske or generally available knowledge provides proper motivation for the modification(s). As the Federal Circuit discussed extensively in *In re Lee*, 277 F.3d 1338; 61 U.S.P.Q.2D (BNA) 1430 (Fed. Cir. 2002), “[w]hen patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.” Citing *In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2D (BNA) 1635, 1637 (Fed. Cir. 1998), the *Lee* Court goes on to state that “there must be some motivation, suggestion,

or teaching of the desirability of making the specific combination that was made by the applicant”. *Id.*

The need to show the motivation with specificity has long been recognized by the courts. *Id.* For example, the *Lee* Court cites *In re Kotzab* for the legal requirement that “particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”. *Id.*; *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2D (BNA) 1313, 1317 (Fed. Cir. 2000). Further, the *Lee* Court cites *In re Rouffet* for the legal requirement that a proper showing of motivation, “even when the level of skill in the art is high, ... must identify specifically the principle, known to one of ordinary skill, that suggests the claimed invention.” *Id.*; *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2D (BNA) 1453, 1459 (Fed. Cir. 1998).

Adamske provides two embodiments for network-based document delivery. The Office primarily relies on the second embodiment in which the client performs some of the processing, e.g., generates a metafile and print preview (col. 6, lines 24-57). The Office proposes to modify this embodiment with teachings of the first embodiment in which the client sends an electronic document to a server and displays a preview in a browser (col. 4, line 61-col. 6, line 23). The Office’s motivation for the modifications is to “reduce the processing load at the client.” (page 12 of Final Office Action).

However, the first embodiment of Adamske (col. 4, line 61-col. 6, line 23) provides a solution in which the processing load at the client is reduced from that in the second embodiment. As a result, by its express teachings, Adamske has already addressed the motivation cited by the Office and teaches away from the Office’s proposed modifications and

Applicants' claimed invention. Since proper motivation is not found in Adamske, Applicants respectfully submit that the Office fails to show that Adamske or the prior art provides proper motivation for the modifications proposed by the Office without using the hindsight of the present invention.

D. Conclusion

In light of the above, Applicants respectfully submit that the Office has failed to make a *prima facie* showing that the claimed invention is unpatentable over Adamske. As a result, Applicants respectfully request withdrawal of the rejection of claim 20 and claims 21-23, which depend therefrom, as allegedly being obvious in view of Adamske.

CLAIM 24

With respect to claim 24, Applicants note that the Office relies on its interpretation of Adamske with respect to claims 12 and 20 in holding that several features of claim 24 are allegedly taught or suggested by Adamske. To this extent, Applicants herein incorporate the arguments presented above with respect to claims 12 and 20.

With further respect to claim 24, the Office fails to show that Adamske teaches or suggests the claimed means for assembling a copy based on configuration information. In support of its rejection, the Office states that Adamske allegedly discloses "style options". However, Applicants note that the phrase "style options" does not appear anywhere in Adamske. Regardless, the Office fails to show that Adamske includes any configuration information that is used both in generating a preview of a configured copy of the document and in assembling a copy of the document as in the claimed invention.

As a result, Applicants respectfully request withdrawal of the rejection of claim 24 and claims 25-27, which depend therefrom, as allegedly being obvious in view of Adamske. However, should the Office maintain its rejection, Applicants respectfully request that the Office cite that portion of Adamske that allegedly discloses configuration information that is used both in generating a preview of a configured copy of the document and in assembling a copy of the document as in the claimed invention.

CLAIM 29

With respect to claim 29, Applicants note that the Office relies on its interpretation of Adamske with respect to claims 12 and 20 in holding that several features of claim 29 are allegedly taught or suggested by Adamske. To this extent, Applicants herein incorporate the arguments presented above with respect to claims 12 and 20. As a result, Applicants respectfully request withdrawal of the rejection of claim 29 and claim 30, which depends therefrom, as allegedly being obvious in view of Adamske.

CLAIM 31

With respect to claim 31, Applicants note that the Office relies on its interpretation of Adamske with respect to claims 17 and 20 in holding that several features of claim 31 are allegedly taught or suggested by Adamske. To this extent, Applicants herein incorporate the arguments presented above with respect to claims 17 and 20. As a result, Applicants respectfully request withdrawal of the rejection of claim 31 as allegedly being obvious in view of Adamske.

CLAIM 28

The Office further rejects claim 28 as allegedly being unpatentable over Adamske in view of U.S. Patent No. 5,873,073 (Bresnan). Initially, as previously argued by Applicants with respect to claim 12, the Office fails to show that Adamske teaches the generation of a user interface that includes a preview area for displaying a preview that is based on a print file and configuration information for a document.

With further respect to claim 28, the Office fails to show that additional features of the claimed invention are taught or suggested by Adamske. For example, the Office fails to show that Adamske teaches, *inter alia*, an “interface [that] provides a preview section and a printing options section that allows a user to provide configuration information (i.e. style options)” (page 10 of Final Office Action). Initially, Applicants note that the phrase “style options” does not appear in Adamske. Further, the Office cites col. 7, lines 16-56 of Adamske in support of its rejection. However, this portion of Adamske is unrelated to previewing the document, let alone describing an interface that provides a preview section and a printing options section.

In response Applicants’ previous arguments, the Office appears to allege that selecting black and white or color printing comprises “style options” (page 12 of Final Office Action). However, Applicants note that the user in Adamske is only able to make this selection after the user has verified the print preview, at the operational screen shown in FIG. 3 of Adamske (col. 6, lines 58-60). This operational screen clearly does not include both a preview area and a configuration area. To this extent, Applicants submit that Adamske fails to teach, *inter alia*, the preview area or the configuration area of the claimed invention. The combination of Adamske with Bresnan does not cure this defect.

In light of the above, Applicants respectfully request withdrawal of the rejection of claim 28 as allegedly being obvious in view of Adamske and Bresnan. In the alternative, should the Office maintain its rejection of claim 28, Applicants again request that the Office particularly point out that portion of Adamske that allegedly teaches a graphical user interface that includes a preview area, a navigation area, and a configuration area as in the claimed invention.

CONCLUSION

Finally, Applicants note that the Office continues to misinterpret the claimed subject matter of various claims. For example, in rejecting claims 17, 29, and 31, the Office states that “Adamske does not disclose that the customized memo is obtained from the client.” However, Applicants note that the claimed subject matter for each of these claims does not include obtaining a customized memo from the client.

Applicants submit that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicants do not acquiesce to the Office’s interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter that have not been expressly addressed herein. Additionally, Applicants do not acquiesce to the Office’s combinations and modifications of the various references or the motives cited for such combinations and modifications that have not been expressly addressed herein. These features and the appropriateness of the Office’s combinations and modifications have not been separately addressed herein for brevity. However, Applicants reserve the right to present such arguments in a later response should one be necessary.

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,



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